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Comments and suggestions are welcome by e-mail to ruth.nyblod@uspto.gov.

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Nicholas P. Godici

Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

While we await the naming of a new director of the United States Patent and Trademark Office, I will serve as the acting under secretary of commerce for intellectual property and acting director of the USPTO while continuing in my current position as the commissioner for patents.

The recent presidential election and change in the administration impacts all federal agencies. The USPTO is no exception. However, this does not change the agency's commitment to our customers and the nation. Working with the new administration, the USPTO will continue to focus on the quality of our products and services, progress in e-government initiatives, and timely processing of our work. The executive committee and I will continue to work together to keep this agency focused on our mission with a clear understanding of the importance of intellectual property to our national and global economy.

The strength of the USPTO has always been and will continue to be the dedication and professionalism of each and every one of its employees. With their support, and with the support of our customers, I am confident that the USPTO will continue to excel now and into the future to serve the new administration and the American people in support of the greatest intellectual property rights system in the world.

USPTO Breaks Ground for New Headquarters in Alexandria

by Jim Nowak, Office of Space Acquisition

On January 17, 2001, the United States Patent and Trademark Office, in partnership with the General Services Administration and LCOR, Inc., broke ground for USPTO's new consolidated headquarters in Alexandria, Virginia. Approximately 350 guests attended the ceremony that was held under a large tent on the Carlyle site directly adjacent to the future site of the new campus.

On a day many thought would never come, the USPTO reached a major milestone in the agency's history. This new state-of-the-art facility complements USPTO's mission in a multitude of ways, and provides a highly skilled workforce with the quality of work life necessary to attract and retain the very best.



from left: Alexandria Mayor Kerry Donley; U.S. Rep. James P. Moran; former Commerce Deputy Secretary Robert L. Mallett; former Under Secretary Q. Todd Dickinson; U.S. Sen. John Warner; former GSA Regional Administrator Nelson B. Alcalde; and Bill Hard, Executive Vice President, LCOR, Inc. In the background is Alexandria's T. C. Williams High School Jazz Band.

Prior to the ceremonial groundbreaking, former GSA Regional Administrator Nelson B. Alcalde; U.S. Sen. John Warner; U.S. Rep. James P. Moran; Alexandria Mayor Kerry J. Donley; Bill Hard, Executive Vice President, LCOR, Inc.; and former Deputy Secretary of Commerce Robert L. Mallett, joined former Under Secretary Dickinson on stage for a round of speeches.

Senator Warner invited all of the PTO employees “to walk through Alexandria... I want every employee to see themselves as a trustee of the magnificence of this community from 1724 to today and into the future....”

Congressman Moran, who also supported bringing USPTO to Alexandria, added, “The USPTO will bring about \$15 million in revenue a year. Any city in the country would have given their right eye to get it... We worked hard to see that the USPTO stayed in Virginia, and I am proud that it’s going to be in the eighth district.”

Alexandria Mayor Donley, who presented USPTO, Commerce Department, and LCOR officials with the keys to the city, reflected, “When I was a young person growing up in Alexandria, this was not a very welcoming spot. This was the site of the Alexandria scrap yard and the Alexandria landfill. When I was first elected to the City Council in 1988, we started a process of vision. We went about a comprehensive, community-wide effort to develop the plans for the Carlyle site. It was that council and that process that developed the plan for the Carlyle site and what has become the home for the Patent and Trademark Office. Not only will what was once a scrap yard and trash dump become the world home for intellectual property, but it will and does represent smart growth....”

Actual construction is scheduled for Summer 2001. The first phase of occupancy will occur in mid 2003 and full occupancy is scheduled for fall 2004.

Technology Center 2100 Business Methods Partnership Meeting

The inaugural business methods customer partnership meeting will be held on Thursday, March 1, 2001, from 1:00 p.m. to 4:00 p.m. at the USPTO Patent Academy, Crystal Square 4, Suite 700, 1745 Jefferson Davis Highway, Arlington, Virginia.

Submit requests for attendance at the meeting to Wynn Coggins, industry outreach coordinator, by fax: 703/305-3719, or by e-mail: wynn.coggins@uspto.gov. Requests for attendance must include the attendee’s name, affiliation, title, mailing address, and telephone number. Facsimile number and Internet mail address would also be appreciated. Requests must be received by February 23, 2001, and will be honored on a first-come, first-served basis.

Call Wynn Coggins for further information: 703/308-1344.

The Patent Business – Part Four

A Conversation with Esther M. Kepplinger Deputy Commissioner for Patent Operations



*by Anne M. Houghton, Office of the Deputy
Commissioner for Patent Resources and Planning
(Ms. Houghton is on detail assignment to the USPTO from the National
Science Foundation.)*

The following is part four of a four-part series on the Patent Business. Part one featured an interview with Commissioner of Patents, Nicholas Godici; part two, an interview with the Deputy Commissioner for Patent Resources and Planning, Edward “Kaz” Kazenske; and part three, an interview with Stephen Kunin, Deputy Commissioner for Patent Examination Policy. This month, part four features an interview with Esther M. Kepplinger, Deputy Commissioner for Patent Operations.

Esther M. Kepplinger is responsible for all patent examining functions in the six patent technology centers, and all operational aspects of patent application initial examination, patent publications, and international PCT [Patent Cooperation Treaty] applications processing. Esther’s career includes over 25 years of experience in intellectual property and over 10 years of organizational management and leadership experience. She shares her views on the Patent Business in this interview and the future of the operations for this innovative government agency.

AH - What does the term “Patent Business” mean to you?

EK - To me in operations, the Patent Business means everything from the front end of the applications coming into OIPE [Office of Initial Patent Examination] through the examination and through publication at the other end. It means that we need to look at operations more as a business. I think increasingly we’ve been doing that over the last few years since we became fully fee-funded. It means that we need to be continuously looking at ways to improve how we accomplish these tasks, in terms of quality of the products and services that we deliver, and also looking at becoming more cost efficient and cost effective. We need to be striving

always to deliver better and better products more efficiently and at a lower cost.

As a fully fee-funded organization, a fundamental aspect of this, with respect to our business, is focusing on the continued generation of revenues that are necessary to perform all of these functions. But fundamental to us--and one thing that makes us very different from any other government agency--is that we constantly have to keep an eye toward ensuring that we're bringing in enough revenue to cover the costs of an expanding business. We have to be very careful in terms of the cuts that we make, because if we cut some of the things that will be generating revenue for us downstream, it will have a tremendous impact on the future of the business.

AH - As deputy commissioner for patent operations, what do you see as the most significant work force issues facing the Patent Business over the next five years and how do you plan to address them?

EK - Well, the good news and the bad news for the USPTO is the economy. It has generated tremendous growth in patent applications as technology has been burgeoning. At the same time, it has created a situation where we are in competition with the other technologically driven organizations for a very small pool of skilled employees. Additionally, we are increasingly having a difficult time in retaining or accessing the fees that we generate through the work that we're doing. So I think that the growth of the applications, the challenge of attracting and retaining skilled employees, and the retention of our fees are three of the big issues that are facing us.

The ways that we are looking to address these are interesting and increasingly important. I think one of the most basic approaches is to look at reengineering the processes of how we handle and examine the applications. This goes from one end of the spectrum, such as the reengineering project that we're piloting right now in technology centers 1600 and 3700 in which we peel off some of the tasks away from the examiners and push the work to the lowest possible level, to legislative changes.

I think that we're also going to need to look at legislative changes to our processes that could have more dramatic impacts on the way that we do our business and shorten or change the way we do examinations so that we're able to do more with less resources. We need to explore creative ways to more effectively utilize the employees that we have and also to use the pool of skilled workers that exist out in the marketplace. For example, we can utilize retirees that may be skilled examiners but have retired and perhaps

relocated in some other part of the country. Is there a way that we can still get them to examine some applications? That would be using flexiplace to take advantage of people with knowledge to do our work but who have moved to another part of the country.

Another approach is knowledge management as a mechanism for taking advantage of the breadth of knowledge that we possess in our current employees. We need to find ways for transferring that knowledge more quickly from the more experienced examiners to those examiners coming in so we can get them up to speed faster.

Statistics show that increasingly the younger workers don't look at a particular place as a career. They are moving from one job to another more quickly. We have to find ways to take advantage of that, getting them up to speed more quickly, so that we get more benefit from their skills while they are here. But we also are looking at ways to advertise ourselves as a training ground. We already serve as a training ground for the law firms. Maybe we can find ways to harness that and make it work more effectively for both us and future employers.

We are exploring avenues to get access to more of our fees so that we will be able to make the investments in the infrastructure and the tools that we need in order to better keep up with the growth of applications.

I think that there's also one other challenge, and that is the quality of our products and services, particularly our products. That continues to represent a very important aspect to our applicants as shown in our customer surveys. I think with the rapid growth of literature in both U.S. and foreign patents, it's increasingly more difficult to keep up with the pace.

Another challenge is funding and improving systems that we need for accessing those sources of prior art and getting our employees trained and comfortable with using those tools in order to effectively identify the best prior art that we can in the applications.

AH – How many of those initiatives do you think can be implemented within the next five years?

EK - I think we can implement many of the ones involving internal processes: hiring, retaining people, reengineering, and flexiplace. Also, we can create an electronic filewrapper and improve our electronic tools needed to complete our jobs. Those are things that we can do within the next five years. The legislative changes are obviously more controversial, require more time, and are more

difficult for us to change. In five years it is possible to make changes, if we are very aggressive in pursuing the things that we need and emphasize the importance of them. Since patents and intellectual property continue to play a tremendous role in the economy, it is critical that we keep pace with our growth and make changes that are essential to keep us in the forefront of technology.

AH - What strategy do you propose to attract qualified applicants to compensate for attrition and the increase in more cases, particularly in the complex arts?

EK - Well again, this is truly one of the challenges. As a government agency, we do have the ability to offer attractive options to employees. We have done a tremendous amount over the last year to increase the flexibilities and improve the quality of worklife that we offer to our employees. I think that one of the things that we need to continue doing is looking at those kinds of quality of worklife aspects that we can address because that is the one area in which we can successfully compete with others. Our objective and our goal will be to continue to improve and add options for the employees that make this an attractive place to work, a place where they can earn a good salary, have a challenging and rewarding occupation, and still at the same time have a quality life that allows them to work at home and to maintain a good home life.

We'll also be focusing on, as I indicated earlier, creative ways of harnessing additional areas of the workforce that maybe we haven't tapped. We'll explore relationships with organizations to find mutually beneficial programs to gain skilled employees for a few years. We gain their expertise and they gain knowledge and training in intellectual properties. This could require reengineering our examination process to find more creative ways to access their knowledge. We'll look at how we can get the most effective use of those individuals for the time that they stay with the USPTO rather than sending them through the same track that we currently have of moving from a junior examiner to a primary examiner. If we understand that these people are never going to stay here long enough to become primary examiners, then we can look at alternative ways of utilizing them.

Another different approach to alternate workers includes employing some people who are very knowledgeable in the fastest growing technologies in which we experience hiring difficulties. We may be able to make use of their knowledge as consultants to examiners or use them in some way in a team with other examiners so that they're able to transfer that knowledge.

We're also exploring ways to change the compensation that we provide. We've been working with all of our unions in this arena, looking at mechanisms for providing as much compensation as we can, looking at salary increases, different ways of providing awards and benefits, upskilling programs, and increasing the number of GS-15s. But with all of these things, we are looking at them from the perspective as a business. The bottom line has to be a cost benefit analysis of all of these things. Certainly we intend to fairly compensate our employees, but at the same time we have to recognize the need to generate fees. It is essential that we maintain a revenue stream, but we are certainly willing to look at all of these things as long as we can make a good business case.

AH – It sounds like you're doing many things to make this place very attractive to working women as well, particularly two income families and women returning to work. Are you targeting potential employees with those types of family situations?

EK - Absolutely. Interestingly, the population of working women has changed dramatically since I started in the office. When I came in 1973, there were a handful of women examiners, mostly in the chemical discipline with very few in the mechanical or electrical areas. We have grown tremendously since that time. I truly believe that much of what we offer allows for a very rich and complete home life. Our best potential hires are women because they are very interested in a rewarding career while at the same time being able to take care of the family at home. Additionally, we are attractive to both men and women who have a working spouse or partner. With all of our employees, both men and women, the interest has been more in family life and flexibility, especially with two income families as compared to more money. As an organization, we provide a wide range of flexibility and a great career, which I believe, makes us the best agency in government.

AH - From the Patent Business perspective, what do you believe are the most important factors to retaining qualified employees and maintaining employee satisfaction? Do you have any new initiatives for the next two fiscal years?

EK – I believe the keys to retention and employee satisfaction are communication, empowerment, and quality of life. We have been addressing the quality of life issues, and we're looking at mechanisms for increasing the level of communication. We instituted an employee mailbox for employees to ask questions, and we give answers to them. We had an internal conference in December to provide information about a variety of topics including the commissioner's performance agreement and quality issues. I

believe employees want more communication and discussion from their first line supervisors, and I am considering ways to ensure that that occurs.

The answer to retaining qualified employees is not always money. Certainly with some of the employees it is money, and it is always going to be difficult for us to compete with the private sector in that area. But one way I'd like to continue to improve the quality of life in order to keep our valuable employees is to empower them, look at ways to allow them to give greater contribution into the direction that the office goes, and try to find ways to allow them to have more of a say in developing ideas for how we address the problems and issues that are facing us. I think these are the kinds of things that contribute to employee satisfaction.

I know that we're not succeeding yet in all of those, but it's not for a lack of trying. We have a long way to go but we are working to improve in that area. We are looking at upskilling some of our other employees, such as our technical support staff, to provide them additional skills for better jobs. We're identifying what the jobs will be in the future, mechanisms for providing the necessary training to gain the knowledge, skills, and abilities required for these jobs, and ways for them to transition to higher paying jobs. We are looking at reengineering in order to take away some of the tasks that the examiners do. The idea is to push the work down to the lowest level possible in order to be most cost effective. We want to use our most skilled employees to do the highest level, most difficult jobs.

AH – I've asked several questions about workforce, which is only a portion of your job as deputy director for patent operations. Do you have any other thoughts that you'd like to provide about operations regarding the patent business, its future, and your role?

EK - The challenges that we have in operations with the growth of applications overlaid on the passage of the AIPA, which sets specific timeframes for us to accomplish the jobs of each of the different parts of the 14-4-4-4-36, make this a particularly interesting and challenging time for us. We have a tremendous growth of applications at the same time that we now will be required to give patent term extension if we fail to meet these time frames. So I think that we have some real challenges ahead of us in figuring out how to more effectively and efficiently get all of these tasks done.

We'll be looking at our job in a slightly different way. We've had the opportunity to transition to cycle time, so this is just an extension of that, but it's extended to each aspect of the work. It will be a real challenge to the examiners because it is keeping all these balls

in the air at once. I recognize that fact, but I know that we've been doing a very good job. The examiners have been stepping up to the plate and reducing all of the backlogs in each of those areas. We really appreciate that, and I know that they'll continue to do a great job along those lines.

AH – What is your vision for the future?

EK – My vision for the future stems from something my mother always impressed upon me: be the best that you can be. I feel that as an organization as a whole and individually, we should strive to be the best at what we do. We already do a tremendous job but there is always room for improvement. My vision is to achieve our strategic goals and provide exceptional and timely quality products and services to our customers.

Silent Heroes: African-American Inventors

by Richard J. Apley, Director of the Office of Independent Inventor Programs

US Airways Chairman Stephen M. Wolf wrote an article wherein he posed the following question: Who are the true heroes of the twentieth century? He went on to list many candidates that he felt historians would honor as the heroes of our time. In his entire essay Mr. Wolf never mentioned an inventor. Sadly, our silent heroes did many of our greatest accomplishments. Americans take pride in being a self-reliant people. We have always admired creative, innovative, and inventive people. We are in constant debt to inventors. Invention is a never-ending process of creating new things and expanding the usefulness of things that already exist. Our everyday world is filled with the products that come from the efforts of inventive minds. Yet, despite the tremendous impact of inventors on our lives, we take them for granted. Most Americans can rattle off the names of their favorite singing group or football team, yet would struggle to name the inventor of the traffic signal or the Super Soaker.

This month has been designated Black History Month. Let's celebrate the diversity of America's creative spirit. In compiling an honor-roll of the inventors and would-be inventors whose work has dramatically changed and enriched our lives, how many African-

Americans would be listed? Most Americans of any race would be hard pressed to come up with the name of a half-dozen African-American inventors. From this, one might conclude that African-Americans have had little interest or success in inventing. The truth is we can hardly get through a day without taking advantage of the creative genius of African-American inventors. African-Americans developed the processes that bring sugar to your table and shoes to your feet, that lubricate much of society's machinery and that carry frozen pizza to your home. You cannot tee up a golf ball, bait a fishhook, stop at a traffic signal, or have fun with a Super Soaker without bumping up against an African-American innovation. A large percentage of these inventors were independent inventors. Their struggles were typical of all independent inventors: lack of money; but never a lack of spirit and determination. All inventors have a common trait: they keep their mind on the objective and not on the obstacles. So, the next time you go into Ben & Jerry's for a scoop of your favorite ice cream think of Alfred Cralle. Why? Because he invented the ice cream scooper.

I want to thank Nathan Aaseng for providing the material for this article. His book "Black Inventors" chronicles the lives of 10 African-American inventors. As Mr. Aaseng notes, African-American inventors have altered and enriched the world in which we live and are worthy subjects for study. One day when we watch Tiger Woods tee-up a golf ball we'll think of George Franklin Grant, the inventor of the modern golf tee.

Major Improvements Achieved in Trademark Pre-Exam

by Jessie Marshall, Office of the Commissioner for Trademarks

The Trademark organization experienced tremendous growth in 2000, receiving 296,490 trademark applications including 375,428 classes for registration. Application filings increased 27 percent in each of the past two years. This was substantially above the initial budget planning level for fiscal year 2000 of 282,000 applications that established funding and staffing levels for fiscal year 2000. However, this exciting growth came with its own set of challenges.

In the past year USPTO averaged nearly 6,000 new application

filings a week, receiving between 2,900 and 8,300 a week, with an average of 850 filed electronically. Backlogs of unprocessed applications developed as filings increased significantly without a comparable increase in staffing. The Pre-Examination section of the Trademark Operation was on the front line in dealing with processing these increases into the application system.

The vast majority of applications are filed on paper in a non-standard format requiring the office to convert application data into electronic systems. The process requires a number of separate processing steps before data is captured, reviewed, and transferred into TRAM, the Trademark Reporting and Monitoring system. Once data is transferred to TRAM a filing receipt can be generated and mailed to the applicant. The filing receipt is important for several reasons. It provides notice that the application has met the initial filing requirements for a filing date and assigns a serial number as a reference for future correspondence regarding the application. Once information has been recorded in TRAM it may be accessed by anyone needing information regarding the status of trademark applications that have been filed at the USPTO through the systems that are available in the office or through the USPTO Web site.

Two changes were implemented in the last half of fiscal year 2000 that contributed to the significant reduction in time to process data from paper filed applications: contractors were hired to supplement government staff, and the process was streamlined. Contractors were hired on a term basis and the contractors worked from electronic images and data that were produced by scanning paper using optical character recognition technology to review data for transfer to the TRAM system. The length of time from filing to mailing a filing receipt dropped from 107 days to nine days over a six-month period, a significant improvement considering a backlog of some 60,000 files was eliminated and the mailing of filing receipts has remained under the office goal of 14 days.

It should be noted that the process for generating a filing receipt for applications that are filed electronically through e-TEAS, the trademark electronic application system, is much simpler and as a result takes less time. Applicants receive an electronic filing receipt that includes the full text of their application exactly as it was submitted upon filing or the same day. Data is received in an electronic format that permits expedited transfer to TRAM, improving access for everyone, reducing processing steps, and improving the reliability and quality of the data that is transferred. Electronically filed applications are received and processed in an e-commerce law office that is designed to handle all processing and

examination activities for applications filed through e-TEAS. It is in the best interests of both applicants and efficient office processing for applications to be filed electronically whenever possible.

Another challenge presented by the increase in application filing was maintaining accuracy in producing the filing receipts for applications that were filed on paper. By installing an excellent new management team in the Pre-Examination area of the office, changes are starting to occur in this area. The backlog in processing filing receipt corrections has been eliminated. A 100 percent quality review of all information uploaded into the database has been instituted. Contractors tag the information to be uploaded and the information is checked by government employees before the information is uploaded into the database. The objective is to get the information into our database accurately at the front end of the process.

There are always more challenges and more work to be done to meet those challenges. These significant improvements in the Pre-Examination section of the Trademark Operation are the most recent advances made in the area of accuracy, efficiency, and customer satisfaction.

Faces of the USPTO

Jo-Anne Barnard is the administrator for space acquisition of the United States Patent and Trademark Office. Ms. Barnard directs the project that will consolidate and relocate the USPTO from its current 18 leased buildings in Crystal City, Arlington, Virginia five miles south to a 2 million square foot campus-type facility on the Carlyle site in Alexandria, Virginia. The \$1.3 billion 20-year lease with LCOR Alexandria LLP is the largest lease ever executed by the federal government.



Immediately prior to coming to the USPTO, Barnard practiced real estate and corporate law at Willkie Farr and Gallagher's Washington office, where she focused on large real estate acquisitions, refinancings, and corporate restructurings. Before entering private law practice, Barnard worked for 16 years at the U.S. General Services Administration. She joined GSA as a

management intern in 1974 and, from 1981 to 1986, held a series of senior management positions at GSA's Public Buildings Service including three years as deputy assistant commissioner for space management, a year as acting assistant commissioner for facility planning, and a year as executive assistant to the commissioner of public buildings. At PBS, Barnard focused on reengineering GSA's real estate leasing and capital investment processes. In this role, she frequently testified before Congress to justify the agency's annual construction, building purchase, and leasing programs.

From 1987 to early 1989, Barnard directed the space management program in GSA's National Capital Region. In that role, she was responsible for management of the NCR's 30 million square feet of leased space; inventory management and assignment of the region's total space inventory of approximately 65 million square feet; the initial tenant construction of about 4 million square feet of then newly-acquired space; and numerous major space consolidation projects (including the Nuclear Regulatory Commission at White Flint and NOAA at Silver Spring, Maryland, and the U.S. Marshals' at Lincoln Place, Arlington, Virginia). In late 1989, Barnard transferred to the USPTO to assist the office in preliminary planning for the future space consolidation. During this period, she worked with USPTO staff and GSA to acquire the Crystal Mall 1 and South Tower Buildings for USPTO use.

Ms. Barnard received a Bachelor of Arts degree from Middlebury College in 1969 and a Juris Doctor, summa cum laude, from Georgetown University Law Center in 1990, where she graduated second in her class. She is a member of Phi Beta Kappa and a recipient of the Order of the Coif. She is married to Jim Barnard and resides in Old Town Alexandria. She has one daughter, Karen, and four grandchildren.

Helpful Hints

for Trademark Applicants

Electronic filers - if you're cutting and pasting from the on-line *Identification of Goods and Services Manual*, please do not use entries that include parentheses. These are just cross-references for entries that do not contain parentheses. Since use of parentheses in identifications causes unnecessary delays because they have to be removed, it is in the filers' interest to avoid using them. Use the entries that do not contain parentheses when preparing your on-line application.

USPTO 2001 Spring Video Conference Series

E-Learning Lecture Schedule

The Video Conference Center Lectures reflect the USPTO's current and largest introduction into e-learning for its patent examiner and public sector constituents. Public sector lectures are offered through the USPTO's videoconferencing facilities at partnership Patent and Trademark Depository Libraries in Sunnyvale, California; Detroit, Michigan; and Houston, Texas. Currently these are the only locations the lectures will be offered to the public.

The subjects offered mirror learning requirements in the ongoing in-house Practice and Procedures technical curriculum. Listed below is a schedule of upcoming courses for the next several months. Please remember that start times listed are Eastern Time. Each partnership PTDL site is in a different time zone, therefore you must check with them for accurate local starting times. Most lectures run about two hours, however some may go as long as three hours. The schedule of lectures is confirmed for participation at the time of publishing, however it is subject to change based upon agency needs.

<u>TITLE</u>	<u>DATE</u>	<u>TIME</u> (Eastern Time)	<u>LECTURER</u>
Patent Cooperation Treaty (PCT) I	February 13, 2001	1:00 PM	Carol Bidwell
Patent Cooperation Treaty (PCT) II	February 15, 2001	1:00 PM	Carol Bidwell
Response by Applicant	February 20, 2001	1:00 PM	Carlos Azpuru
Double Patenting	February 22, 2001	1:00 PM	Leo Picard
Board of Patent Appeals and Interferences	March 13, 2001	1:00 PM	Bruce Stoner
Petitions	March 15, 2001	1:00 PM	Brian Hearn
Trademark Trial and Appeal Board Issues	March 27, 2001	1:00 P.M.	Cindy Greenbaum/Gerard Rogers
Unity of Invention	March 29, 2001	1:00 PM	Jerry Massie
PCT I	April 10, 2001	1:00 PM	Carol Bidwell
PCT II	April 12, 2001	1:00 PM	Carol Bidwell
Trademark Tips for Paralegals	April 24, 2001	1:00 PM	Janice Long/ Hope Slonim
112.2 nd Paragraph	April 26, 2001	1:00 PM	Nelson Moskowitz
Novelty 35 USC 102	May 01, 2001	1:00 PM	Tom Will
Affidavits 37 CFR 1.31 & 1.32	May 10, 2001	1:00 PM	David Lacey
Re-Issue and Re-Exam	May 15, 2001	1:00 PM	Kenneth Schor/ Joe Narcavavge
Obviousness 35 USC 103	May 24, 2001	1:00 PM	David Moore
New Rule Changes	June 05, 2001	1:00 PM	Robert J. Spar
Response by Applicant	June 07, 2001	1:00 PM	Carlos Azpuru
PCT I	June 19, 2001	1:00 PM	Carol Bidwell
PCT II	June 21, 2001	1:00 PM	Carol Bidwell

Contact your closest partnership PTDL for information on times, registration fees, or to register:

Sunnyvale Center for Innovation, Invention and Ideas

Sunnyvale, California

Phone: (408) 730-7290

Great Lakes Patent and Trademark Center

Detroit, Michigan

Phone: (313) 833-3379

South Central Intellectual Property Partnership

at Rice University

Houston, Texas

Phone: (713) 348-5196

VIDEOCONFERENCE COURSE DESCRIPTIONS

Patents

Affidavit Practice: 37 CFR 1.131 and 1.132:

The information provided in this session is a great benefit to attorneys/applicants because it teaches the USPTO's way of doing things. The lecture is designed to teach examiners the analytical skills needed to evaluate whether an affidavit filed under 37 CFR 1.131 may be used as evidence to swear behind a reference, and whether an affidavit filed under 37 CFR 1.132 may be used as evidence to overcome a ground of rejection or an objection. When attorneys/applicants know what is needed in each affidavit type, and when it is appropriate to employ an affidavit, prosecution can be much more effective, lending credence to the old saying "it ain't what you do but the way that you do it!"

Board of Patent Appeals and Interferences:

All you've ever wanted to know about the BPAI will be presented in this seminar: Who sits on the board, what training and experience are required, what is a panel, what each member does, and caseload considerations start the session. How the BPAI judges are trimming appeals inventory and speeding up interferences will also be discussed.

The lecturer will explain the process and procedures required when making an appeal to the Board including how to contact an oral conduct hearing, BPAI decisions and requests for rehearing. The BPAI also conducts and decides interferences, so the presenter will also cover the process used in an interference case.

Double Patenting:

Learn how the Patent Academy teaches examiners to treat applications containing claims which conflict with claims in applicant's other applications or patents, or claims in other commonly assigned (or owned) applications. Topics include:

- Grounds for prohibiting double patenting;
- Treatment of conflicting claims;
- Terminal disclaimers;
- Protection against Double Patenting rejections;
- Conflict between design and utility claims; and
- Duplicate claims

The session will end with an exercise that will enhance the absorption of the material presented.

Obviousness under 35 USC 103:

Understand the meaning of 35 USC 103. Learn to apply the standards used to establish a legal conclusion of obviousness. Treat the various issues that inevitably arise when applying 35 USC 103. By the end of this session, you should be able to recognize and understand the following concepts related to obviousness:

- The statute;
- Prima facie obviousness;
- The Graham test;
- Scope and content of prior art;
- Evidence of prior art comprising references, admissions and affidavits;
- Analogous art; and differences between the prior art and the claims at issue.

Attendees will also gain a level of skill in the pertinent art comprising:

- Motivation;
 - Hindsight;
 - Motivation different from applicant's;
 - Art recognized equivalence for the same purpose;
 - Physical incorporation;
 - Destroying a reference;
 - Changing principle of operation and number of references combined;
- and
- Secondary considerations comprising unexpected result; long felt need; and commercial success will also be discussed.

With all this valuable information, it is “obvious” that you need to take this class!

Novelty 35 USC 102:

Participants will learn to determine whether a reference qualifies as prior art under 35 USC 102 (a), (b), or (e) and determine whether a single reference teaches all the elements of a claimed invention.

Petitions:

Every patent attorney needs to know how to handle petitions expeditiously, efficiently and with a minimum of error. You will learn the basic principles of petition practice and the two main avenues of ex parte review – appeal and petition. Identify the various types and components of petitions handled in the Office of the Deputy Commissioner for Patent Examination Policy, as well as in the Examining Corp and the requirements that MUST be met to

have a petition granted. Become more effective in your practice before the office by getting guidance on how to 1) avoid the most common errors that lead to petitions in the first place, and 2) avoid errors in the petitions themselves.

Changes to Patent Practice and Procedure - New Rules

Changes

Changes to Patent Practice and Procedure - New Rules Changes is a comprehensive lecture covering primarily the rules changes of the American Inventors Protection Act of 1999, (AIPA), and the Patent Business Goals-Final Rule, (PBG-Final Rule). The first portion of the lecture highlights some of the significant changes to patent practice and procedure wrought by passage of the AIPA and its implementation. Topics include Patent Term Guarantee, the Request for Continued Examination Practice, Pre-Grant Publication (PG-Pub), and *Inter Partes* Reexamination. The first portion of the lecture also focuses on changes to 35 USC § 103(c) and 35 USC § 102(e) and § 374 made by the AIPA.

The second portion of *Changes to Patent Practice and Procedure - New Rules Changes* addresses some of the important rules changes as published in the PBG-Final Rule. These changes are part of the office's continuing efforts to streamline and simplify the process of applying for and obtaining patent protection for new inventions. The lecture will focus on those rules which best eliminate unnecessary requirements for applying for and obtaining a patent, remove impediments to electronic filing, reduce costs to the public and the office, and clarify previously complicated technical rules.

Lastly, a brief overview concerning other rules changes such as the changes relating to unlocatable files and payment of USPTO fees by credit card will be provided, as well as an overview of significant practice changes such as OIPE review of drawings, Electronic Filing System (EFS) submissions, and PCT CD filings.

Reexam and Reissue

The lecture provides an overview of the *ex parte* reexamination and reissue programs established pursuant to the statutes (35 U.S.C. 251 and 35 U.S.C. 302-305), rules (37 CFR 1.172-1.179 and 37 CFR 1.510-1.552), and MPEP requirements governing reissue applications and *ex parte* reexamination proceedings, respectively. The objectives include enabling the practitioner to understand reissue practice as a post-issuance activity for correcting errors in issued patents, and reexamination practice as a litigation alternative. The overview will include some policy highlights of the office's implementation efforts for optional *inter partes* reexamination. The attendee will learn:

- To understand how the key provisions of the statutes and rules apply to the examination process of reissues and *ex parte* reexaminations;
- To understand the instances where patents are eligible for *inter*

partes reexamination;

- To understand the primary similarities and differences between the examinations of reissue applications, *ex parte* reexamination proceedings, and regular utility applications;
- To understand the criteria for granting a request for reexamination;
- To understand the scope of *ex parte* reexamination proceedings; and
- To recognize the importance of and the emphasis on a reissue oath/declaration and to be able to distinguish such from the oath or declaration of a utility application.

35 USC 112-2 paragraph, Rejections Not Based on Prior Art:

This session will analyze the claims to determine whether or not one skilled in this art can determine the metes and bounds of a claim with a fair degree of certainty. Attendees will be taught to understand the criteria for determining clear and distinct claim language, and understand the policy reasons for 35 USC 112-2. The session also enables the practitioner to understand appropriateness of rejections in accordance with 35 USC 112.

Response by Applicant:

It is very important to understand the proper form when dealing with the USPTO. It makes life easier and helps avoid delays. This session enables the attendee to determine when a response to an Office Action is correct and complete. It will guide the applicant on the proper course of action to be taken when the response is incorrectly filed. To state it simply, it covers the who, what and when of responses-WHO is the proper person to file? WHAT is considered a proper response? And WHEN is it due?

Unity of Invention:

The objective is to understand unity of invention practice as it applies to national stage applications filed under 35 USC 371 and to international applications filed under the Patent Cooperation Treaty. The participants will be able to determine how unity of invention practice applies and whether claims in a given application lack unity of invention.

The Patent Cooperation Treaty:

This is a two-part lecture on the Patent Cooperation Treaty. Representatives from the PCT Special Programs Office of the USPTO teach a basic seminar on practice and procedures of the Patent Cooperation Treaty from filing an international application to entering the national phase in the USPTO.

Patent Cooperation Treaty (PCT) Part I:

The first session starts with an overview of the PCT process including the international phase and the national phase as well as the advantages of using PCT for filing foreign patent applications. Next the participants are given detailed information on how to file an international application. Partici-

pants are taught how to properly fill out a PCT Request form including information on using PCT –EASY, the self-validating software for generating the Request.

Patent Cooperation Treaty (PCT) Part II:

The second session continues with information on filing a Demand for International Preliminary Examination. Next participants learn about national stage entry in the US under 35 USC 371 and an alternative strategy for filing a US patent based upon the international application. The session ends with helpful hints on the PCT process including how to record changes in the applicant, how to delay or prevent publication of the international application, and a discussion of important forms that should be monitored during the international phase.

TRADEMARKS

Trademark Tips for Paralegals:

This seminar will provide an explanation of the trademark process aimed at non-attorney legal professionals. Legal staff of the Office of the Commissioner for Trademarks will provide an explanation of the trademark process, including an overview of the office and updates on pendency for new applications. They will provide insight on why trademark applications go abandoned; tips to avoid abandonment; and what to do when your application is abandoned. They will briefly explain the difference between a petition and an appeal and a petition and a request for reinstatement. They will also provide a list of contacts at the PTO and other handouts, to help you get the right answer, right away.

Trademark Trial and Appeal Board Issues:

Topics for discussion include: the pre-trial phase of opposition and cancellation proceedings including pleadings and discovery, the trial and decision phases of opposition and cancellation proceedings including the submission of trial evidence and how recently proposed rule changes would affect practice before the TTAB.

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